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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,149	12/14/2001	Paul A. Flaherty	M-8631 US	1681

7590 03/17/2006  
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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/022,149	Applicant(s) FLAHERTY, PAUL A.	
	Examiner Pierre E. Elisca	Art Unit 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6-20 and 22-32 is/are rejected.
- 7) ☒ Claim(s) 5 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to Applicant's response filed on 12/22/2005.
2. Claims 1-32 are pending.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action;

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-20 and 22-32 are rejected under 35 U.S.C. 102 (e) as being anticipated by Webb et al US 2002/0071076 A1 filed on August 16, 2001.

**As per claims 1-4, 6, 7 and 8-9 Barnes** discloses an electronic coupon in a retail member store 340, a data center 310 needs to serve the coupon to a user by way of an electronic barcode on the user's cellular telephone 302 or other device 314. For example, the user may use the wireless Internet-enabled device to visit the data center web site and scan through a list of the user's current electronic coupons. If the user selects a product from this list for purchase, the web site may include a selection

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mechanism whereby the data center 310 is prompted to deliver the barcode coupon to the user's display device (e.g., cellular telephone 302). The data center 310 then and/or the cellular telephone network 303, and the barcode indicating the manufacturer's coupon is thereby displayed on the user's device 302, 314 **see., Webb, page 2, [0017], page 5, [0055], page 8, [0084] and [0088]** (which is readable as Applicant's claimed invention wherein said

a client process executable on a processor in a two-way communication device, the two-way communication device, a server process executable on a processor communicatively coupled over the network to the client process, and coupon depository or storage coupled to the server process capable of storing a plurality of particular coupons, a coupon depository coupled to the server process capable of storing a plurality of coupons, the coupons including an encoding of a barcode image, the server process including an operation of sending a particular coupon to the client process, the client process including an operation for decoding the respective barcode image encoding corresponding to the particular coupon and displaying the respective barcode image on the display screen (**see., Webb, page 2, [0017], page 5, [0055], page 8, [0084] and [0088]**).

**As per claims 10-12, 14-20 and 22-32 Webb** discloses an electronic coupon in a retail member store 340, a data center 310 needs to serve the coupon to a user by way of an electronic barcode on the user's cellular telephone 302 or other device 314. For example, the user may use the wireless Internet-enabled device to visit the data

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center web site and scan through a list of the user's current electronic coupons. If the user selects a product from this list for purchase, the web site may include a selection mechanism whereby the data center 310 is prompted to deliver the barcode coupon to the user's display device (e.g., cellular telephone 302). The data center 310 then and/or the cellular telephone network 303, and the barcode indicating the manufacturer's coupon is thereby displayed on the user's device 302, 314 **see., Webb, page 2, [0017], page 5, [0055], page 8, [0084] and [0088]** (which is readable as Applicant's claimed invention wherein said

a client process executable on a processor in a two-way communication device, the two-way communication device, a server process executable on a processor communicatively coupled over the network to the client process, and coupon depository or storage coupled to the server process capable of storing a plurality of particular coupons, a coupon depository coupled to the server process capable of storing a plurality of coupons, the coupons including an encoding of a barcode image, the server process including an operation of sending a particular coupon to the client process, the client process including an operation for decoding the respective barcode image encoding corresponding to the particular coupon and displaying the respective barcode image on the display screen (**see., Webb, page 2, [0017], page 5, [0055], page 8, [0084] and [0088]**).

**As per claims 13 and 22, Webb** discloses the claimed limitations wherein the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers (see., fig 7).

***Allowable Subject Matter***

5. Claims 5 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**RERESPONSE TO ARGUMENTS**

6. Applicant's arguments have been fully considered but they are moot in view of new ground (s) of rejection.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

**Primary Patent examiner**

**March 14, 2006**